

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Application of:**

|                         |   |                      |                 |
|-------------------------|---|----------------------|-----------------|
| <b>Application No.:</b> | 10/568,063                                      | <b>Examiner:</b>     | Jolley, Kirsten |
| <b>Filing Date:</b>     | July 17, 2006                                   | <b>Art Unit:</b>     | 1792            |
| <b>First Inventor:</b>  | Manfred Heim                                    | <b>Customer No.:</b> | 23364           |
| <b>Attorney No.:</b>    | HEIM3001/JJC/PMB                                | <b>Confirm. No.:</b> | 7469            |
| <b>For:</b>             | <b>SECURITY ELEMENT WITH THIN-LAYER ELEMENT</b> |                      |                 |

**PETITION TO THE DIRECTOR UNDER 37 C.F.R. §§ 1.144 AND 1.181(a)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTORY COMMENTS**

This petition to the director under 37 C.F.R. §§ 1.144 and 1.181(a) is responsive to the Office Action dated April 28, 2009 in the above application, wherein the restriction requirement under 37 C.F.R. §1.142 is made final.

In view of the following remarks, withdrawal of the restriction requirement is respectfully requested.

**REMARKS**

Reconsideration and withdrawal of the restriction requirement is respectfully requested on the basis of the following particulars.

1. Statement of Facts

The pending application is the national stage entry under 35 U.S.C. § 371 of international application PCT/EP2004/008912, filed August 9, 2004. As such, the making of a restriction requirement in the pending application is governed by the lack of unity standard discussed in 37 C.F.R. §§ 1.499, 1.475, and 1.476 (MPEP §§ 823 and 1893.03(d); 35 U.S.C § 372(b)(2)).

A review of the file history of the international application PCT/EP2004/008912 indicates that the international search report and written opinion prepared by the International Searching Authority were prepared on the basis of claims 1-63, without requiring an invitation to pay for the searching of additional claims on the basis of lack of unity.

The Office action dated December 15, 2008 made a restriction requirement on the basis of lack of unity between the following groups:

Group I, claims 1-30, drawn to a product of a security element containing a layer of particle-containing color-shifting ink;

Group II, claims 31-45, drawn to a process of printing a security element containing a layer of particle-containing color-shifting ink;

Group III, claims 46-54, drawn to a composition or intermediate product, a particle-containing color-shifting ink;

Group IV, claims 55-64, drawn to a process of producing a particle-containing color-shifting ink.

Applicants elected Group II, claims 31-45, and timely traversed the restriction requirement in the response filed January 14, 2009.

The restriction requirement was made final in the Office action dated April 28, 2009, on the basis that the claims of Groups I and II were found to lack unity *a posteriori* in view of U.S. publication no. 2004/0177789 (*Heider et al.*), since it has been asserted that the *Heider* publication discloses the special technical feature shared by the claims of Groups I and II.

The *Heider* publication has a filing date of December 17, 2003, which is later than the August 12, 2003 filing date of the foreign priority document DE 10337331.4 of the pending application. Thus, the *Heider* publication cannot be considered a prior art reference under 35 U.S.C. § 102(e) or § 103(a).

2. Points to be Reviewed

A. The claims of the international application had unity of invention

As noted above, the claims of the international application, of which the pending application is the national stage entry in the U.S., had unity of invention. The International Searching Authority did not find that the claims of the international application lacked unity of invention under PCT Rule 13.

As noted in MPEP § 1893.03(d), 37 C.F.R. § 1.475 was amended effective May 1, 1993 to correspond to PCT Rule 13.

Accordingly, it is respectfully submitted that since the International Searching Authority did not find that the claims of the international application lacked unity of invention under PCT Rule 13, the U.S. Patent and Trademark Office cannot find that the claims of the pending application lack unity of invention under 37 C.F.R. § 1.475, which corresponds to PCT Rule 13.

B. The special technical feature shared by the claims of at least Groups I and II is not disclosed by the prior art

As discussed in detail in the election filed January 14, 2009, and the Office action dated April 28, 2009, the claims of Groups I and II share a special technical feature such that a spacer layer is formed by a printed layer/printing method with a printing ink having dispersion particles with monomodal or oligomodal size distribution.

As discussed in the response filed July 28, 2009, and as acknowledged in the Office action dated April 28, 2009, U.S. patent no. 6,761,959 (*Bonkowski et al.*) fails to disclose a spacer layer formed by a printing ink having dispersion particles with monomodal or oligomodal size distribution.

As discussed above, and in detail in the response filed July 28, 2009, the *Heider* publication cannot be considered a prior art reference under 35 U.S.C. § 102(e) or § 103(a).

Further, as discussed in detail in the response filed July 28, 2009 the *Heider* publication fails to disclose printing a spacer layer of a thin-layer element.

Thus, it is respectfully submitted that the special technical feature of a spacer layer formed by a printed layer/printing method with a printing ink having dispersion particles with monomodal or oligomodal size distribution shared by the claims of at least Groups I and II is not disclosed by the prior art.

C. The claims of at least Groups I and II have unity of invention

Since, as discussed above in section B, the prior art does not disclose the special technical feature shared by the claims of at least Groups I and II, it is respectfully submitted that the claims of at least Groups I and II have unity of invention under 37 C.F.R. § 1.475.

3. Action Requested

In view of the foregoing remarks, withdrawal of the restriction requirement and examination on the merits of at least the invention of Group I, claims 1-30 is respectfully requested.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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